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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Peter Francis Daniel et al. Art Unit : 1652
Serial No. : 09/641,471 Examiner : E. Slobodyansky
Filed : August 18, 2000
Title : HIGH MANNOSE PROTEINS AND METHODS OF MAKING HIGH
MANNOSE PROTEINS

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

In response to the restriction requirement mailed December 7, 2001, Applicants elect group II, claims 105-171, directed to a method of producing a high mannose glucocerebrosidase (hmGCB). Applicants respectfully traverse the restriction requirement for the following reasons.

Applicants traverse the division of groups III and (I, II and IV). The Examiner asserts that groups III and (I, II and IV) are related as product and process of use. In fact, groups III and II, as well as groups III and I, are related as product and process of making the product. The Examiner argues that the compounds of group III can be used in the method of group IV (with which Applicants agree) and in "the in vitro production of a purified enzyme by the method of invention I." As discussed above, invention I is not a method of using the compound at all, but rather a method of making the compound. Thus, the Examiner has not established that either (a) the compounds of group III can be used in a materially different process than those of group IV, or (b) the method of using of group IV can be practiced with another materially different product. In addition, Applicants note that the claims in group IV depend from claim 181 (in group III). The Examiner has shown no clear evidence of a separate status in the art or any indication of a different field of search for group III and the group IV. Moreover, the Examiner has not established that a serious burden would be involved in searching group III and group IV

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Serial No. : 09/641,471
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Attorney's Docket No. 010278-017001 / 00-2

simultaneously. Therefore, Applicants respectfully request that, at least, group IV be reclassified with group III.

In addition, Applicants traverse the division of groups I and II. The Examiner argues that the methods of invention II "employ a recombinant cell." However, all the claims in group II are not so limited.

Applicants also traverse the division of groups II and IV. The Examiner states that "[m]ethods of inventions I and II are *in vitro* methods that are patentably distinct from an *in vivo* method of invention IV." Applicants note that invention II is not limited to *in vitro* methods. There is sufficient similarity between the groups that they could be searched together without serious burden to the Examiner.

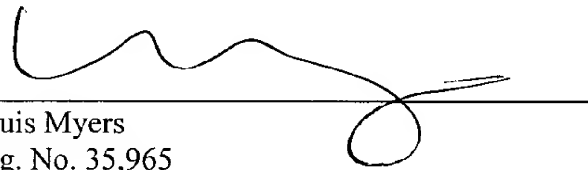
No fees are believed to be due at this time. However, if there are any charges or credits, please apply them to Deposit Account No. 06-1050, referencing the attorney docket number indicated above.

Respectfully submitted,

Date: _____

7 Jan 02

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